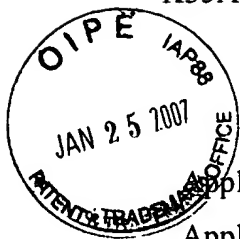


K35A0687 (WESDIG.046A)

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : William B. Boyle

Group Art Unit 2621

Appl. No. : 09/747,002

Filed : December 22, 2000

For : METHOD AND APPARATUS FOR
STORING A STREAM OF VIDEO
DATA ON A STORAGE MEDIUM

Examiner : Jamie J. Vent

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Applicant requests a pre-appeal brief review of the legal and factual basis of the rejections in the October 20, 2006 Final Office Action. No amendments are being filed with this request, and this request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheets.

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REASONS FOR THE REQUESTED REVIEW

In the October 20, 2006 Final Office Action, the Examiner rejects Claims 17-29 under 35 U.S.C. § 103(a) as being unpatentable by U.S. Patent No. 6,134,384 issued to Okamoto et al. ("Okamoto") in view of U.S. Patent No. 6,792,000 issued to Morinaga et al. ("Morinaga"). This Final Office Action is a first office action issued after the December 20, 2005 filing of a Request for Continued Examination (RCE) with a "Response to November 17, 2005 Advisory Action" and a "Declaration of William B. Boyle Pursuant to 37 C.F.R. § 1.132."

Claim 17

Applicant submits that the Examiner has not identified a teaching, suggestion, or motivation in the prior art to combine the teachings of Okamoto and Morinaga to produce the claimed invention as recited by Claim 17. Applicant also submits that the Examiner has improperly not considered the "Declaration of William B. Boyle Pursuant to 37 C.F.R. § 1.132" ("the Declaration"). Applicant will address each of these points in turn.

The Examiner Has Not Identified A Motivation To Combine The References

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. In re Kahn, 441 F.3d 977, 986 (Fed. Cir. 2006); M.P.E.P. § 2143.01. The teaching, suggestion, or motivation must be found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000); M.P.E.P. § 2143.01.

In the October 20, 2006 Final Office Action, the Examiner asserts that it is well known that many storage mediums "are available for" storing data, citing Hatano (U.S. Patent No. 6,951,031) and Grooters (U.S. Patent No. 6,549,718). Explaining that Hatano and Grooters disclose systems allowing "the ability to use" various recording mediums to store a processed data stream, the Examiner concludes that these references in conjunction with Okamoto and Morinaga show that "a system **can** have various mediums for storing data" (emphasis added).

However, Applicant submits that none of these statements identify a motivation to combine Okamoto and Morinaga to produce the claimed invention. While the prior art may disclose that systems "can" have multiple storage media, Applicant submits that the prior art does not disclose or suggest using the method of storing data on a tape drive as disclosed by Okamoto for storing data on a disk drive as disclosed by Morinaga. "The mere fact that references can be

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combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. § 2143.01(III), citing In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Therefore, neither the references cited by the Examiner nor the Examiner’s assertions of general knowledge in the art in the October 20, 2006 Final Office Action provide a motivation to combine the teachings of Okamoto and Morinaga.

Furthermore, as explained in the “Response to November 17, 2005 Advisory Action,” which is incorporated in its entirety by reference herein, Okamoto and Morinaga also do not include a motivation to combine Okamoto and Morinaga to produce the claimed invention. Thus, Applicant submits that there is no suggestion to combine the teachings of Okamoto and Morinaga to produce the method recited by Claim 17.

The Examiner Has Not Considered The Declaration

According to M.P.E.P. § 716.01, “[e]vidence traversing rejections, when timely presented, must be considered by the examiner whenever present” and examiners should acknowledge and comment on such evidence (e.g., the Declaration) in the “next succeeding action” after the evidence was submitted. Id. If the evidence is insufficient to overcome the rejection, “the examiner must **specifically explain** why the evidence is insufficient” (emphasis added). Id. “General statements . . . without an explanation supporting such findings are insufficient.” Id.

In the October 20, 2006 Final Office Action, the Examiner does not acknowledge the Declaration. Applicant also submits that the Examiner has not commented on the sufficiency of the evidence contained therein. At most, the Examiner offered only general statements that “Applicant’s arguments ... have been fully considered but they are not persuasive” and that “applicant’s points are understood [but] the examiner cannot agree.” These statements lack the specificity required by M.P.E.P. § 716.01.

As discussed in the “Response to November 17, 2005 Advisory Action,” the Declaration explains that (i) combining the disclosure of Morinaga with the disclosure of Okamoto would require a substantial reconstruction and redesign of the elements shown in the Okamoto reference as well as a change in the basic principle under which the system and method of Okamoto was designed to operate, and (ii) the claimed invention recited by Claim 17 provides results which are unexpected from the combination of Okamoto and Morinaga. Therefore, the teachings of Okamoto in view of Morinaga are not sufficient to render Claim 17 *prima facie* obvious and the

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claimed invention recited by Claim 17 provides substantial and unexpected results which obviate a finding of obviousness.

For at least the above-stated reasons, Applicant submits that Claim 17 is patentably distinguished over the prior art, and respectfully requests that Claim 17 be passed to allowance.

Claims 18-25

Each of Claims 18, 20, and 22-25 depends from Claim 17, Claim 19 depends from Claim 18, and Claim 21 depends from Claim 20. Thus, each of Claims 18-25 includes all the limitations of Claim 17, as well as other limitations of particular utility. For at least the reasons stated above with respect to Claim 17, Applicant submits that each of Claims 18-25 is patentably distinguished over the prior art, and respectfully requests that these claims be passed to allowance.

Claim 26

For at least the reasons stated above with respect to Claim 17, Applicant submits that the prior art does not provide a suggestion to combine the teachings of Okamoto and Morinaga to produce the claimed invention as recited by Claim 26. Therefore, Applicant submits that Claim 26 is patentably distinguished over the prior art, and respectfully requests that Claim 26 be passed to allowance.

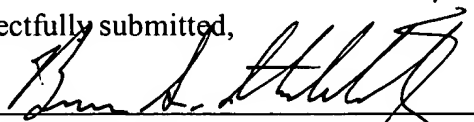
Claims 27-29

Each of Claims 27 and 28 depends from Claim 26 and Claim 29 depends from Claim 28. Thus, each of Claims 27-29 includes all the limitations of Claim 26, as well as other limitations of particular utility. For at least the reasons stated above with respect to Claim 26, Applicant submits that each of Claims 27-29 is patentably distinguished over the prior art, and respectfully requests that these claims be passed to allowance.

Summary

For the foregoing reasons, Applicants submit that Claims 17-29 are in condition for allowance, and Applicants respectfully request such action.

Dated: 1/22/07

Respectfully submitted,

By: _____
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